Your ref:	H11790GB-RAL	**Examiner:**	Mr David Maskery
Application No:	GB0620414.3	**Tel:**	01633 813545
Applicant:	Fisher Rosemount Systems, Inc	**Date of report:**	5 December 2007
Latest date for reply:	12 February 2008	**Page 1/3**	

Patents Act 1977
Examination Report under Section 18(3)

Basis of the examination

1.   In the examination of your application I have taken account of the amended claims you filed with your agent's letter of 5 November 2007 to amend the application as it was printed by WIPO during the international phase. I confirm that I have taken into account the International Preliminary Report on Patentability dated 7 November 2006.

Patentability

2.   Your invention is not a patentable invention for the purposes of the act. That is to say, the invention described in your claims is excluded from patent protection under section 1(2)c of the act.

3.   The correct approach to take deciding matters under section 1(2) is the four-step test of *Aerotel/Macrossan*[1] as given by the court of appeal judgement. The steps are:

(1) properly construe the claim
(2) identify the actual contribution
(3) ask whether it falls solely within the excluded subject matter
(4) check whether the actual or alleged contribution is actually technical in nature.

The above steps will be applied to the configuration system of claim 1 and the methods of claims 19 and 36, and the facts of the present application, as given in the description.

4.   I would also like to draw your attention to decisions O/148/07, O/149/07, O/150/07 O/151/07 and O/152/07 on cases GB 0324470.4, GB 0514158.5, GB 0514161.9, GB 0514164.3 and GB 0514167.6 respectfully. All five decisions relate to earlier Fisher-Rosemount Systems Inc applications which were objected to on the grounds of excluded matter and appear to relate to similar subject matter to this application.

Step 1 - properly construe the claim

5.   Your claim 1 is to a configuration system for use in manufacturing plant to control the processes in the plant. The plant has physical items that are operated by logical entries to control the plant and thus perform the required processes. The physical items in the plant are

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[1] *Aerotel Ltd v Telco Holdings Ltd (and others) and Macrossan's Application* [2007] R.P.C. 7

[Examination Report contd.]

connected to a process controller that executes a control routine based on logical process entries of the known logical processes, and thus control the operation of the plant.

6.   The configuration system consists of three main parts, a template executable graphic display, a database and a configuration engine. The template executable graphic display has visual depictions ie icons of, I assume, the physical items in the plant and some of their operating parameters, a parameter memory that stores a value associated with the physical items and the logical entries and a binding memory that stores a reference for connecting the parameter memory to a data source within the plant associated with the physical and logical process entries. The graphic display is created and stored separately from the entries and without the references for connecting the parameter memory to the data source.

7.   Claim 19 is a method of configuring the control systems of a process plant and claim 36 to a method of using the configured control systems, based on the configuration system of claim 1.

Step 2 - identify the actual contribution

8.   The physical parts of the system, ie the processing plant, valves, pumps, vats etc, are well known standard items. The physical parts of the control system such as the computers, the data storage resources and network communications, are also well known items. This is shown in the documents cited in the original international search report. In particular WO 95/04314, US 2004/0075689 and US 5706455, all of which disclose configuration systems for controlling process plants. All the control systems are configured using graphical displays using templates depicting the physical items and the logical entries, and by accessing a parameter database and memory of the connections between the items.

9.   As there are no details of any changes to the hardware of the control system of the process plant the contribution must lie in the changes to the software of the control system, ie how the display is configured to show a representation of the process plant, such as the physical items, the logical processes by which they operate and the connections between them. The template **executable** graphical display, the configuration **database**, and the configuration **engine** that create the graphical display, are all software, as given in paragraphs 54 and 173 - 179 of your description.

Step 3 - ask whether it falls solely within the excluded subject matter

10.   The contribution lies in the use of and interconnection of a new configuration engine to generate the new graphical display program from the database and details in the parameter memory. All of these are software elements of the overall system. Thus as the contribution lies in the excluded field, ie, as a program for a computer as such, claims 1, 19 and 36 are excluded. Furthermore, claim 19 as a method of configuring the process plant, ie deciding where the display goes and what they display is a mental act and is thus excluded as such.

[Examination Report contd.]

11.   The dependent claims all refer to additional improvement and details of the graphical display, database or the configuration engine, thus any contribution from the rest of the claims also lies in the excluded field, and hence the claims as a whole are excluded as relating to a program for a computer as such.

Step 4 - check whether the actual or alleged contribution is actually technical in nature

12.   Having found that your invention fails step 3, I have no need to apply step 4. As a result, I am not applying step 4.

Clarity

13.   Due to the nature of the above patentability objection a full examination of the claims has been deferred, but when amending the claims the following clarity observations should be taken into account.

14.   On line 6 of claim 1 there is no indication of what the one or more visual depictions displayed are depicting which makes the claim unclear and ambiguous.

15.   Furthermore, in the second part of claim 1 (lines 6 – 14) it is not clear whether physical and logical entries are the items in the process plant, as suggested by the opening line of the claim, or their virtual identities as suggested by the rest of the claim. This make this part of the claim unclear as to what is meant the step of storing the executable graphical display (software) in a different place to the physical and logical entries (hardware or software?).

16.   Claim 19 is to a method of configuring a process plant ie the placement of the working parts of the plant on the factory floor, whereas the steps of the method and the rest of the application are to methods of configuring the control systems and the software of the control systems of a process plant. This make the scope of the claimed method unclear and ambiguous.

17.   The statement of invention given in paragraph 15 needs to be updated to reflect the amended claims.

18.   The list of documents given in paragraph 1 of your description can not be incorporated by reference as they not been published at you priority date, as incorporating them would count as added matter. Note, only document US 2004/0075689 can be so incorporated as it was published 2 weeks before your priority date.